REMARKS

Claims 1, 2, and 13-26 remain before the Examiner for reconsideration. Claims 1, 13 and 15 have been amended. The amendments to Claims 1, 13 and 15 are set forth in an Appendix hereto including markings to show the revisions made to those claims. In the Appendix, deletions are indicated by bracketing, and insertions are indicated by underlining.

In the final Office Action dated September 17, 2002, the Examiner rejected Claims 1, 2, and 13-20 under 35 U.S.C. 112, first paragraph, "as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Specifically, the Examiner asserted that "amended claims 1, 13, and 15 include an 'attachment member." The term cannot be found in the specification."

Although such an attachment member is inherently part of the support member of the present invention, Applicant has amended to the claims to remove the term "attachment member" therefrom. Applicants respectfully assert that the claims as amended fully comply with the requirements of Section 112.

The Examiner also rejected Claims 1, 2, and 13-26 under 35 U.S.C. Section 103(a) "as being unpatentable over Harkness [U.S. Patent No. 5,467,992] in view of Carney [U.S. Patent No. 6,213,887]." Specifically, the Examiner asserted that:

> Harkness discloses a device support member worn around a person's head and an attached laser light (abstract) generating a linear alignment beam of light visible to the person to provide an alignment of the person's body when in position to perform the task as stated in claims 1 and 2 (figs. 2 and 3). Harkness also discloses a cylindrical lens and positions the lens to direct the beam of light as in claim 2 (fig 4 and col 3, lines 20-26). Regarding claims 19 and 20, Harkness does not disclose the device around the chest or hips of the user. Harkness does disclose the device as being interchangeable among different items. However, moving the device from

> one body part to another is a method of use, which is not relevant to the structure of the device. Harkness discloses a spot of light on the ground and does not disclose a line of light. However, Carney teaches a line of light alignment. One skilled in the art would have modified the invention of Harkness with Carney by changing the spot of light to a line of light to provide a more accurate alignment means for the user.

Applicant respectfully traverses the Examiner's assertion.

Applicant respectfully asserts that the Examiner's assertion that Harkness disclosed "a linear alignment beam of light visible to the person to provide an alignment of the person's body when in position to perform the task" is clearly erroneous. Once again, Harkness does not even address the problem of determining alignment of any portion of the body the user thereof. Harkness discloses the use of a light spot projected onto the ground to aid a golfer in observing head movement during a golf swing. Indeed, the above scope of the invention of Harkness is well set forth in Harkness and summarized succinctly in the abstract of Harkness as follows:

> A method for using a light spot projecting aid to observe head movements during a golf swing and to provide a golfer with an explanation (i.e., cause) of the effect manifested as the light spot being moved.

Unlike the present invention, Harkness provides no information to the user thereof of a plane transversing the person's eyes or any other portion of the person's body.

The Examiner further asserts that "one skilled in the art would have modified the invention of Harkness with Carney by changing the spot of light [projected by the device of Harkness] to a line of light to provide a more accurate alignment means for the user." Why would one skilled in the art modify Harkness "to provide a more accurate alignment means" when the device of Harkness is not designed to provided information on alignment of the user's body, but to provide an indication of head movement? Indeed, there is absolutely no motivation for one skilled in the art to combine the teaching of Harkness with the teaching of Carney. See, for example, *Ex parte*

Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (P.O. Bd. Appl. 1984) ("The prior art must provide a motivation or reason for a worker in the art without the benefit of appellant's specification to make the necessary changes in the reference device."); Schenk v. Norton, 218 USPQ 698, 702 (Fed. Cir. 1983) ("Modification unwarranted by the disclosure of a reference is improper."); Ex Parte Acosta, 211 USPQ 636, 637 (P.O. Bd. Appls. 1980) (Examiner's combination of two references is improper where there is no basis in the record from which it can reasonably be inferred that one skilled in the art would have been led or motivated to modify the primary reference in the manner proposed by the Examiner.).

Once again, body alignment is irrelevant to the stated sole purpose of the device of Harkness (that is, the detection of motion). Likewise, Carney does not disclose or suggest a means of providing feedback to a person of the actual alignment of any portion that person's body. Carney merely discloses the propagation of a line of light on the ground to indicate the target line to a particular target such as a simulated golf hole. Although Carney discloses a target line of light to which a person may attempt to align a portion of the person's body, the person is provided with no indication of how that portion of the person's body is actually aligned by the device of Carney.

Given the clear deficiencies of Harkness and Carney, Applicants respectfully assert that the Examiner is impermissibly using the disclosure of the present application as a guide in attempting to reconstruct the present invention through combination of Harkness and Carney. See, for example, Yamanouchi Pharmaceutical Co. v. Danbury Pharmacal Inc., 21 F. Supp. 2d 366, 371, 48 USPQ2d 1741, 1745 (S.D.N.Y. 1998), aff'd, 231 F.3d 1339, 56 USPQ2d 1641 (Fed. Cir. 2000) ("obviousness is not determined as if the designer had hindsight knowledge of the patented design."). See also Ecolochem, Inc. v. Southern California Edison Co., 227 F.3d 1361, 56 USPQ2d 1065 (Fed. Cir. 2000) (quoting Dembiczak); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Combining prior art references without evidence of ... a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint

for piecing together the prior art to defeat patentability--the essence of hindsight."); C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998), rehearing denied & suggestion for rehearing in banc declined, 161 F.3d 1380 (Fed. Cir. 1998) ("The invention that was made ... does not make itself obvious; that suggestion or teaching must come from the prior art."); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051-52, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so); Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (it is insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor); Fromsom v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (the prior art must suggest to one of ordinary skill in the art the desirability of the claimed combination); In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) ("rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'"); Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996) ("The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made.").

Moreover, even if one were to combine the source of a line of light disclosed in Carney with the device of Harkness (for which combination there is no motivation in the disclosure of Harkness, Carney or any combination thereof), one would not arrive at the present invention. As clear from the disclosure of Harkness and as demonstrated to the Examiner in the interview of March 4, 2002, the spot of light of Harkness does not even provide information as to the alignment of the cap on the

person's head (which need not be aligned with the orientation of the person's head) as the device need not be placed on the cap to project the light in any specific orientation. Converting the spot of light projected by the device of Harkness to a line of light would not provide a line of light generally parallel to the alignment line passing transversely through any portion of the person's body (for example, the eyes, chest or hips) as claimed in the present invention. In that regard, there is absolutely no disclosure in Harkness or Carney, to provide a support member on the body of a user to maintain a source of a generally linear alignment beam of light in a position on the person's body so that the generally linear, alignment beam of light is generally parallel to a line passing transversely through the portion of the person's body. The Examiner cannot continue to impermissibly ignore this express claim limitation. See Ex Parte Murphy and Burford, 217 USPQ 479, 481 (P.O. Bd. Appls. 1982) ("it is error to ignore specific limitations distinguishing over the cited reference"); In re Boe, 505 F.2d 1297, 184 USPQ 38 (CCPA).

The devices and methods of the present invention provide real time feedback to a person of the alignment of a line passing transversely through a portion of the person's body to provide to the person an indication of the alignment of the portion of the person's body. To provide such information to the user of the device of the present invention is a substantial improvement in the art of, for example, golf instruction. The disclosures of Harkness and Carney do not even address the issue of providing feedback to a person on such alignment, let alone disclose or suggest a method or device to provide such feedback.

The Examiner also rejected Claims 1, 2, and 13-26 "under the judicially created doctrine of obvious-type double patenting as being unpatentable over Claims 1-10 of U.S. Patent No. 5,879,239". Specifically, the Examiner asserted that:

> Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention encompasses the

> `239 patent. The present invention claims the actual device without any specifics regarding location. The `239 patent includes the same subject matter but limits the device to be attached to eyeglasses. One skilled in the art would obviously relocate the device to different areas of the user's body to accommodate the needs of each user.

Applicant has filed herewith a terminal disclaimer to overcome the Examiner's obvious type double patenting rejection.

In view of the above amendments and remarks, the Applicant respectfully requests that the Examiner withdraw the rejection of the claims, indicate the allowability of Claims 1, 2, and 13-26 and arrange for an official Notice of Allowance to be issued in due course.

Respectfully submitted,

CHRISTOPHER M. MACROGLOU

By _____
Henry E. Bartony, Jr., Esquire
Reg. No. 34,772

Bartony & Hare
Law & Finance Building, Ste. 1801
429 Fourth Avenue
Pittsburgh, Pennsylvania 15219
412-338-8632 (telephone)
412-338-6611 (fax)
Attorney for Applicant

Version with markings to show changes made

Please delete the text of Claims 1, 13 and 15 and insert therefore the following:

1. (Four-times Amended) A device for assisting a person in achieving proper alignment of the person's eyes when the person is in position to perform a task, comprising:

a support member [including an attachment member for] to be donned [donning the device] upon the person's head;

a light source attached to the support member, the light source being attached to the support member to generate a generally linear, alignment beam of light on a surface visible to the person, [the attachment member maintaining] the support member maintaining the light source in a position on the user's head such that the alignment beam of light [source provides to the person an indication of] is generally parallel to an alignment of a plane transversing the person's eyes when the person is in position to perform the task.

13. (Thrice Amended) The device of Claim 1 wherein the [attachment member is] support member comprises a band adapted to be worn on the head of the person, the light source being attached to the band to be positioned to the side of one of the eyes of the user.

15. (Twice Amended) A device for assisting a person in achieving proper alignment of a portion of the person's body in a desired direction when the person is in position to execute a golf stroke, the device comprising:

a support member to be worn by the person upon the person's body[, the support member including an attachment member for donning the device upon the person's body];

a light source attached to the support member, the light source being attached to the support member to generate a generally linear, alignment beam of light on a surface visible to the person that is generally parallel to a line passing transversely through the portion of the person's body to provide to the person an indication of the alignment of the portion of the person's body, [the attachment member maintaining the support member in a position on the user's body such that the light beam is generally parallel to a line passing transversely through the portion of the person's body].